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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,786	04/27/2001	Peter Bernhard Kaars	US018054	1689

7590 10/12/2004

Corporate Patent Cousel
Philips Electronics North America Corporation
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EXAMINER	
DURAN, ARTHUR D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/844,786	KAARS, PETER BERNHARD	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/27/01; 5/6/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 2, 4, 5, 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The

phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in

affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 1, 2, 4, 5, 14. At least one step of the body of the claims must explicitly utilize the technological arts or a non-manual process. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 recites the limitation "selected by the individual". There is insufficient antecedent basis for this limitation in the claim. There is no prior stated individual in claim 11 or claim 7. The claim should read "by an individual" or be rewritten in some other manner. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-5, 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396).

Claim 1, 5, 7, 14, 15-18: Gerace discloses a method, apparatus, medium, software for enabling the display of an electronic document with a portion of the document being automatically updated while being displayed:

storage means for storing at least a first and a second content information (Fig. 2; Fig. 3a; col 5, lines 15-40; col 6, lines 20-35); and,

controlling means for causing a display of the second content information in the portion, for, thereafter, causing a display of the first content information in the portion, and, for, upon request, causing a display of the second content information in lieu of the first content information (col 11, lines 24-56; col 6, lines 22-40).

Gerace further discloses a method of enabling to display an electronic document with a portion whose content is automatically changed while the document is being displayed, the method comprising enabling an end-user to override the automatic change (col 11, lines 24-56; col 6, lines 22-40). Gerace further discloes that the enabling to override comprises enabling to cause the portion to display the content type displayed on a previous occasion (col 11, lines 24-56; col 6, lines 22-40). Note that stock or weather information can be displayed and automatically changed or updated. However, the user can also at any time change what is displayed to something new or to a display the content type of what was previously shown.

Gerace does not explicitly disclose that the exact content itself of a prior viewing can be brought up by the user.

However, Gerace further discloses that all user history including user actions and content itself viewed by a user can be recorded (Fig. 3a- Fig. 3g; col 6, line 57-col 7, line 24).

Gerace further discloses user customization and requesting of information (col 11, lines 24-56; col 8, lines 17-25; col 7, lines 60-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's user requesting information to Gerace's recorded history of content viewed. One would have been motivated to do this in order to allow the user to view items of both current and prior interest.

Claim 2, 10: Gerace discloses the method of Claim 1, wherein the first and second content information comprise advertisements (Fig. 2; Fig. 3a; col 2, lines 24-30).

Also, note that advertisements can lead to purchases (col 2, lines 35-42) and that the history of user advertisement interaction is recorded including which specific advertisements (col 6, lines 57-col 7, line 24).

Furthermore, note that it would be obvious to one skilled in the art that any of the viewing control applied to agate information can also be applied to advertisement information. (col 2, lines 24-30; col 7, lines 5-10). One would have been motivated to do this in order to allow the user to view advertisements that were of prior interest for attaining further information or for making purchases.

Claim 3, 8, 11: Gerace discloses the method of Claim 1, wherein the document comprises a selectable graphical user interface element that, upon selection, triggers a request for the display of the second content information (col 6, lines 21-40; col 6, lines 57-col 7, line 4).

Gerace discloses that the first and second content information are selected by the individual (col 6, lines 21-40; col 6, lines 57-col 7, line 4).

Claim 4: Gerace discloses the method of Claim 1.

Gerace further discloses causing the temporary display of the second content information in the portion (col 11, lines 25-56; col 6, lines 21-40). Note that Gerace's user can display content information of one type and then switch to a different set of content information or back to the prior content information at any time or for various viewing durations. In this case, the user is the cause of the temporary display of the content information.

Claim 9: Gerace discloses the electronic document of Claim 7, wherein the control command is received from a separate control device (col 6, lines 57-64).

Claim 12: Gerace discloses the electronic document of Claim 7, wherein the document comprises an electronic program guide (col 1, lines 10-15; col 6, lines 27-33).

Claim 13: Gerace discloses the electronic document of Claim 7, wherein the document comprises a Web page and the portion is a Web frame (col 6, lines 30-40; col 2, lines 35-42; col 1, lines 29-45).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Levitan (5,864,823)

Claim 6: Gerace discloses the display apparatus of Claim 5.

Gerace further discloses the utilization of the Internet and devices connected to the Internet (col 3, lines 37-67; Fig. 1) and the viewing of television (col 36, lines 54-60).

Gerace does not explicitly disclose a set top box.

However, Levitan discloses that the apparatus connected to the Internet can comprise a set top box (col 2, lines 21-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Levitan's set top box to Gerace's devices for the Internet and television viewing. One would have been motivated to do this in order to provide the services of Gerace to a wide variety of devices.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Slotznick (6,011,537) discloses automatically causing the temporary display of the second content information in the portion (Abstract);

b. Angles (5,933,811) discloses a user selecting advertisements for viewing;

c. Dedrick (5,724,521) discloses a user selecting advertisements for viewing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arthur Duran
Patent Examiner
9/21/04

Form PTO-1449 U.S. DEPARTMENT OF COMMERCE (REV. 7-80) PATENT AND TRADEMARK OFFICE	Atty. Docket No. US018054	Serial No.
	Applicant Peter B. Kaars	
INFORMATION DISCLOSURE CITATION (Use several sheets if necessary)	Filing Date CONCURRENTLY	Group

U.S. PATENT DOCUMENTS

Ex. Int.		Document Number	Date	Name	Class	Sub-class	Filing Date If Approp.
/DO	AA	5 2 3 3 4 2 3	Aug. 3, 1993	Jernigan et al.	358	181	Nov. 26, 1990
	AB						
	AC						
	AD						
	AE						
	AF						

FOREIGN PATENT DOCUMENTS

		Document Number	Date	Country	Class	Sub-class	Trans. Yes	Trans. No
	AG							
	AH							
	AI							
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OTHER (Including Author, Title, Date, Pertinent Pages, Etc.)

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Examiner	Date Considered 9/21/04

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP Draw line through citation if not in conformance and not considered. Include a copy this form with next communication to applicant.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

Application Number	09/844,786
Filing Date	04/22/2001
First Named Inventor	KAARS, Peter
Art Unit	2622
Examiner Name	Unknown
Attorney Docket Number	US018054

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Document Number No.-Kind Code[2] (*if known*)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns Lines, Where Relevant Passages or Relevant Figures Appear
		US- 5572643A	11-05-1996	Judson, David H.	
		US-			
		US-			
		US-			
		US-			
		US-			

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No.[1]	Document Number (ctry[3]-no.[4]-kind[5], if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of cited document	Pages, Columns Lines, Where Relevant Passages or Relevant Figures Appear	T[6]
		WO0073961A	12-07-2001	Netzero Inc.		
		WO9847090A	10-22-1998	Sony Electronics Inc.		

NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No.[1]	Include name of the author (in capital letters), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T[6]

Examiner Signature		Date Considered	9/21/04

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[1] Unique citation designation number. [2] See attached Kinds of U.S. Patent Documents. [3] Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). [4] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [5] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. [6] Applicant is to place a check mark here if English language Translation is attached.

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